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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,964	02/27/2004	Peter T. Aylward	84886LMB	6687

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EXAMINER

SCHILLING, RICHARD L

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/788,964

Applicant(s)

AYLWARD ET AL.

Examiner

Richard L. Schilling

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 32-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-31, 32-42, 42-46 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2-27-04</u> | 6) <input type="checkbox"/> Other: ____ |

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-31, drawn to an imaging element, classified in Class 430, subclass 496.

II. Claims 32-41, drawn to a method of making a support material, classified in Class 427, subclass 274.

III. Claims 42-46, drawn to a method of making a support material, classified in Class 156, subclass 244.24.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Groups II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the supports made by Groups II and III need not be used as support materials in the imaging elements of Group I but may be used, for example, as packaging material as in U.S. Patent 4,832,775, cited by applicants. The imaging elements of Group I need not contain supports made by the methods of Group III or Group II but may be made by the method disclosed on page 14, lines 21-23, of applicants' specification.

The methods of Groups II and III are drawn to mutually exclusive independent inventions. Group II requires coating a polymer composition on a polymer foam layer while Group III requires laminating a preformed polymer sheet on a polymer foam layer.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper.

During a telephone conversation with Lynne Blank on April 6, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-31. Affirmation of this election must be made by applicant in replying to this Office action. Claims 32-46 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

2. Claims 15, 29 and 30 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. In claim 15 there is no antecedent basis for the term "said flange sheet" since parent claims 1 and 3 do not set forth flange sheets on the back sides.

In claim 30 there is no antecedent basis for the term "said

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core" since parent claims 26 and 1 do not set forth core layers.

In claim 29, the term "located said flange layer" is indefinite.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) The invention was described in (1) an application for patent, published under Section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language. }

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-31 are rejected under 35 U.S.C. 102(a) or (e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sunderrajan et al. '184. Sunderrajan et al. (see particularly paragraphs 18, 31-38 and 42) disclose imaging elements with supports comprising polymer foam layers and flange layers. The supports may be made from flange layers that are extrusion coated on a polymer foam layer in contact with a textured chill roll. Using a textured chill roll on a flange layer is a method disclosed in applicants' specification for making the flange layer a "camouflaging" flange layer. The textured flange layer would inherently hide or camouflage pits or voids of the polymer foam core at least to some extent. The foam polymer cores of Sunderrajan et al. would inherently have surface roughness values for foamed polymer cores as disclosed in applicants' specification. If Sunderrajan et al. do not anticipate the instant claims, then it would at least be obvious to one skilled in the art to use the disclosed textured chill

rollers as the chill rollers for extrusion coating in Sunderrajan et al.

3. Claims 1-31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dontula et al. '976 or Dontula et al. '659. Dontula et al. '976 (see particularly column 4, lines 26-35; column 6, line 55 - column 7, line 29; column 8, line 58 - column 9, line 11; Example 12) and Dontula et al. '659 (see particularly column 4, lines 6-15 and lines 51-65; column 5, lines 31-40; column 6, line 41 - column 7, line 15; column 18, lines 37-61; column 9, lines 45-60) disclose imaging elements with supports comprising upper flange sheets on polymer foam cores wherein the upper flange sheets comprise paper or opaque polymer sheets which hide or camouflage pits in the polymer foam core. The polymer foam cores would inherently have roughness values as disclosed for polymer foam cores in applicants' specification. The term "camouflage" is not defined in the claims or specification to distinguish over opaque flange sheets which would hide the polymer foam cores. If Dontula et al. '976 or Dontula et al. '659 do not anticipate the instant claims, then it would at least be obvious to one skilled in the art to use the disclosed paper or opaque polymer flange layers as the required upper flange layers on the polymer foam cores of Dontula et al. '976 and

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Dontula et al. '659.

5. The prior art submitted by applicants has been considered. Cleereman et al. is cited of interest in the art as disclosing laminates of polymer foam layers and plastic upper flange layers wherein the plastic layers may be embossed by a laminating roller (column 4, lines 10-43). Miyake et al. is cited of interest in the art as disclosing laminates comprising polymer foam layers, substrates and surface layers with matte surfaces.

6. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (571) 272-1335.

RLSchilling:cdc

April 9, 2005

RICHARD L. SCHILLING
PRIMARY EXAMINER
GROUP 4100 1752

